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| EXAMINER | |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/245,798 | O'DONNELL ET AL. | |
| | Examiner | Art Unit | |
| | Beth Van Doren | 3623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *126-147* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *126-147* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. The following is a Final office action in response to communications received 04/09/2007. Claims 126-147 are pending.

### *Response to Arguments*

2. Applicant's arguments with regards to the 103 rejections based on Johnson et al. (U.S. 5,991,876) of claims 129 and 145 (and their dependent claims) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that (1) it is not obvious to make the information available to the general public and there is no teaching or suggestion in Johnson et al. to make the change to the Johnson system suggested by the examiner.

In response to argument (1), Examiner respectfully disagrees. Johnson et al. discloses a publicly accessible network and storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network of at least the Internet (Column 3, lines 44-57, column 8, lines 1-20, column 9, lines 35-67). Johnson et al. further discloses in column 3, lines 44-57 that potential licensees are allowed to access the system over a network, like the Internet. Therefore, Examiner does not feel that Johnson et al. teaches away from allowing anyone on the publicly accessible network access to records of the database since Johnson et al. discloses allowing potential licensees to access the system as well as the network being the Internet.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is motivation found in the prior art, where is suggests a publicly accessible network and allowing potential licensees to access the system. See column 3, lines 25-50.

3. Applicant's arguments with regards to the 103 rejections based on Johnson et al. (U.S. 5,991,876) of claims 126 and 138 (and their dependent claims) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that (2) nothing in the teachings of Johnson et al. suggests that a user can request or receive a copy of a work of authorship, (3) Johnson et al. does not teach or suggest that the materials are delivered as a consequence of accepting the offered terms and request for an electronic copy or that the copy is automatically sent to the customer across a network, (4) a link is required to a database that contains copies of the works of authorship, which is not taught or suggested by Johnson et al., and (5) Johnson et al. in view of the DOI system do not expressly disclose including in the electronic copy a network address of the webpage containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship or a hotspot linking to this webpage (as per claims 134-135).

In response to argument (2), Examiner agreed with applicant that Johnson et al. does not expressly disclose also receiving a request for an electronic copy and that the third computer is sent via the network an electronic copy of the first work of authorship as a consequence of having received the message. Examiner asserted that Johnson et al. taught electronic rights systems that allow for enforcement of copyrights associated with published documents and also

allows for the obtainment of rights to use these documents. In Johnson et al., once the third computer (the client) accepts the terms and the acceptance is acknowledged the third computer/client, the client is allowed to access and use an electronic copy of the work via the network. Examiner took official notice that it is well-known to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use. Examiner notes that this Official notice was not traversed by the applicant in the current (i.e. subsequent) response, and therefore, per MPEP 2144.03(c), these statements are taken as admitted prior art. Therefore, examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by providing fully automated rights management and authorization. See column 2, lines 40-67, column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

In response to argument (3), Examiner respectfully disagrees. See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client, once being granted rights to use the work, is able to accesses and uses an electronic copy of the work (as it's media of use). The work would not be able to be used with a CD-Rom, intranet, or Internet unless it was electronic. Column 7, lines 40-55, expressly discusses rights including type of use including Internet and intranet use of the work.

In response to argument (4), Examiner respectfully disagrees. First, a link to a database that contains copies of the works of authorship is not specifically recited in the pending claims, so it is not clear what specifically the Applicant is arguing. Johnson et al. discloses databases

and relational databases that can be queried and accessed. See at least figure 4. See also figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client accesses and uses an electronic copy of the work for use. Therefore, based on the 35 USC 103 rejection set forth below, Examiner maintains that Johnson et al. does teach and suggest the claimed invention of claims 126 and 138.

In response to argument (5), Examiner respectfully disagrees. Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35- column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose that the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship or that that the electronic copy includes a hotspot, that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

The DOI system discloses a DOI graphic (i.e. hotspot) included in an electronic copy of a document, the DOI graphic including a network address of a web page, the web page verifying that the publisher is aware of the copy (i.e. through the showing of the graphic), which links the user to a licensing page associated with the work. See reference A, page 1, section 2, reference B, page 2, sections 1-4, reference C, page 1, section 3. Since Johnson et al. and the DOI system are analogous art, both related to rights management with DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent, the combination would be

obvious and the combination does teach the claims as recited. Examiner further notes that Applicant's arguments fail to comply with 37 CFR 1.111(b) with regards to claims 134-135 because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4. Applicant's arguments with regards to the 103 rejections based on Johnson et al. (U.S. 5,991,876) in view of Elsevier Science (www.elsevier.com) of claims 128 and 142 (and their dependent claims) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that (6) it is not obvious to combine the references and (7) that neither Johnson et al. nor Elsevier Science teach or suggest a link to a database that contains printable copies of the works of authorship.

In response to argument (6) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is motivation found in the prior art, on page 2 of Elsever Science, which discusses the need for processing speed with regards to ordering/requesting a copy of a publication that is a paper reprint that is delivered. Since Johnson et al. discloses that an authorized user requests the right to make paper copies, via the clearinghouse system (which

processes the order), sending copies of publications to users based on rights is considered analogous art. Examiner notes that notice was taken by the Examiner that certain subject matter is old and well known in the art with regards to these claims. Per MPEP 2144.03(c), these statements are taken as admitted prior art because no traversal of this statement was made in the subsequent response (ie. The current response).

In response to argument (7), Examiner respectfully disagrees. First, a link to a database that contains copies of the works of authorship is not specifically recited in the pending claims, so it is not clear what specifically the Applicant is arguing. Johnson et al. discloses databases and relational databases that can be queried and accessed. See at least figure 4. See also figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client accesses and uses an electronic copy of the work for use. Therefore, based on the 35 USC 103 rejection set forth below, Examiner maintains that Johnson et al. in view of Elsevier Science does teach and suggest the claimed invention of claims 128 and 142.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**6. Claims 126-127, 129-131, 138, and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876).**

As per claim 126, Johnson et al. discloses a clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work);

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher (See figures 4-6, column 2, line 63-column 3, line 17, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a first and second registration record are recorded);

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship (See the abstract, figure 4, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms);

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship (See figures 2 and 7, column 4, lines 55-67, column 9, line 55-column 10, line 15 and lines 41-60, wherein an offer is presented to the user over the internet using the client/server architecture);

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms, allowing the third computer via the network access to use of an electronic copy of the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged. See also figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client accesses and uses an electronic copy of the work for use).

However, Johnson et al. does not expressly disclose also receiving a request for an electronic copy and that the third computer being sent via the network an electronic copy of the first work of authorship as a consequence of having received the message.

Johnson et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allows for the obtainment of rights to use these documents. Johnson et al. discloses that once the third computer (the client) accepts the terms and the acceptance is acknowledged the third computer/client is allowed to access and use an electronic copy of the work via the network. Examiner takes official notice that it is well-known

to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use. It would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by providing fully automated rights management and authorization. See column 2, lines 40-67, column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

As per claim 127, Johnson et al. teaches wherein the electronic copy includes electronically coded text (See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein an electronic copy of written works, for example, would be electronically coded text).

As per claim 129, Johnson et al. teaches claim 129, elements (a)-(d). Claim 129, elements (a)-(d) are substantially similar to claim 126, elements (a)-(d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 126 above. Johnson et al. further discloses:

presenting on a publicly accessible computer network license offering registration web pages (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work);

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance and request have been received and acknowledged (See figures 2 and 7, column 3, lines 25-55,

column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged);

(f) storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network (Column 3, lines 44-57, column 8, lines 1-20, column 9, lines 35-67, wherein the record is stored and accessible in the system).

However, Johnson et al. does not expressly disclose making the record of the license available to anyone from any computer on the publicly accessible network.

Johnson et al. discloses storing records of accepted licenses and terms of these licenses in the system, wherein the records are available for look-up from a computer on the Internet. Johnson et al. further discloses allowing potential licensees to access the system over a network, like the Internet. It is well known in network security that the availability of a database to be accessed over a network is based on the security settings associated with such data. It would have been obvious to one of ordinary skill in the art at the time of the invention to include low security settings, allowing anyone to access the records concerning licensing agreements in order to more efficiently reduce the illegal use and distribution of copyrighted works by allowing a member of the public to have enough information to verify whether a work is licensed or not, thus allowing the member to contact appropriate persons if the used work is not licensed.

As per claim 130, Johnson et al. teaches wherein the step of presenting license offering registration web pages is performed by a server in the server system and the step of presenting to the third computer a licensing web page is performed by a server in the server system (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15). However, while Johnson et al. discloses a network with client/server functionality and multiple

computers, Johnson et al. does not expressly disclose multiple servers in this client/server network.

A server is merely a computer on a network that "serves" data to the rest of the network. Since Johnson et al. discloses a network with client/server functionality and multiple computers it would have been obvious to one of ordinary skill in the art at the time of the invention to include multiple servers that share the functions of the network in order to increase the efficiency of the network by performing load balancing. See column 11, lines 19-25, wherein the design choices for the system are left up to the programmer, etc.

As per claim 131, Johnson et al. teaches wherein functions of the server system are distributed across a plurality of physical computers and at least one of the server system steps is performed in the first computer (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15, wherein the function of the server system are distributed).

Claim 138 is substantially similar to claim 126, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

Claim 145 is substantially similar to claim 129, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

**7. Claims 128, 142, and 146-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Elsevier Science (www.elsevier.com).**

As per claim 128, Johnson et al. teaches claim 128, elements (a)-(d). Claim 128, elements (a)-(d) are substantially similar to claim 126, elements (a)-(d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 126 above.

Johnson et al. further discloses:

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance and request have been received and acknowledged (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged);

(f) after the message indicating acceptance is received, as a consequence of having received the acceptance, the clearinghouse server system processes the order and allows copying of the work of authorship for printing on paper (See figure 7, column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client request the order of paper copies be supplied).

Johnson et al. further discloses that educational institutions are rights holders that make copies and course packets (See column 2, lines 5-20, column 3, lines 5-15, column 7, lines 40-55, and column 8, lines 15-22, wherein educational institutions make copies in the form of course packets).

However, Johnson et al. does not expressly disclose that the user requests that a paper reprint be delivered, sending a copy to a printer, or delivering the copy.

Elsevier Science discloses that the user requests that a paper reprint be delivered and delivering the copy (See pages 2-3).

However, while Elsevier Science allows users to request published material and have that material delivered, Elsevier Science does not expressly disclose sending a copy to a printer.

Johnson et al. discloses that an authorized user requests the right to make paper copies, via the clearinghouse system (which processes the order). Johnson et al. further discloses storing information about the authorized user, such as the user's address. Johnson et al. further discloses an educational institution making copies of course packets based on permissions granted to make copies. The educational institution would have a copy from which they would print multiple paper copies for use by students. Elsevier Science discloses ordering/requesting a copy of a publication that is a paper reprint that is delivered. It is well known with copyrights and publishing that clean copies are provided to users from which to make copies, such as with Elsevier Science. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to request a paper reprint/copy of the work and supply/deliver this copy to the rights holder in order to increase customer service and the usability of the system by having the publishing system send a copy to the user from which to make copies.

Further, examiner takes official notice that systems that provide requested publications make copies of these publications at their printers before sending these copies to requesters (i.e. a system that allows users to request copies of publications and have that material delivered would have to makes copies before sending copies). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to send a copy to a printer before sending out the copy to the requester of Elsevier Science in order to increase the processing speed of the system of providing publications to requesting users. See page 2 of Elsever Science.

Claim 142 is substantially similar to claim 128, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

As per claims 146-147, Johnson et al. discloses works of publishers, such as stories and anthologies (See column 8, lines 35-57) and securing rights to use these works, such as to make copies (See figure 7, column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60). Johnson et al. does not expressly disclose a copy being sent to a printer. Elsevier Science teaches wherein the copy sent to a printer (See pages 2-3). However, Elsevier Science does not expressly disclose that this copy includes a human readable message indicating the name of the publisher of a first work of authorship.

Johnson et al. discloses that an authorized user requests the right to make paper copies, via the clearinghouse system (which processes the order). Johnson et al. further discloses storing information about the authorized user, such as the user's address. Johnson et al. further discloses an educational institution making copies of course packets based on permissions granted to make copies. The educational institution would have a copy from which they would print multiple paper copies for use by students. Elsevier Science discloses ordering/requesting a copy of a publication that is a paper reprint that is delivered. It is well known with copyrights and publishing that clean copies are provided to users from which to make copies, such as with Elsevier Science. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to request a paper reprint/copy of the work and supply/deliver this copy to the rights holder in order to increase customer service and the usability of the system by having the publishing system send a copy to the user from which to make copies.

Examiner further takes official notice that it is old and well known to list the publisher on a printed story, article, publication, and/or anthology in order to preserve the rights and the identity of the work. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the publisher name in a human readable way on the work in order to more accurately preserve the rights and the identity of the work, thus allowing a user of the work to also know who to contact to get rights to the work.

**8. Claims 133 and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Holmes et al. (U.S. 6,119,108).**

As per claim 133, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

Holmes et al. discloses that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2).

Both Johnson et al. and Holmes et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the message of Holmes et al. that indicates the copy was made with permission of an owner of copyrights in order to more efficiently decrease the illegal use and distribution of copyrighted works and thus ensure that copyright holders receive their appropriate fees. See column 1, lines 5-15, and column 2, lines 5-25, of Holmes et al. that discuss the importance of stopping illegal reuse of copyrighted materials.

Claim 139 recites equivalent limitations to claims 133 and is therefore rejected using the same art and rationale as set forth above.

**9. Claims 136-137 and 143-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Elsevier Science (www.elsevier.com) and in further view of Holmes et al. (U.S. 6,119,108).**

As per claim 136, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose, nor does Elsevier Science, that the electronic copy includes a

human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

Holmes et al. discloses that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2).

Johnson et al. and Elsevier Science both disclose providing access to works of authorship and are combinable for the reasons set forth above with regards to claim 128. Further, both Johnson et al. and Holmes et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the message of Holmes et al. that indicates the copy was made with permission of an owner of copyrights in order to more efficiently decrease the illegal use and distribution of copyrighted works and thus ensure that copyright holders receive their appropriate fees. See column 1, lines 5-15, and column 2, lines 5-25, of Holmes et al. that discuss the importance of stopping illegal reuse of copyrighted materials.

As per claim 137, Johnson et al. teaches a copy being made with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose, nor does Elsevier Science, that the copy includes a network address

of a webpage containing an indication verifying that the copy was made with permission of the owner of copyrights in the first work of authorship.

Holmes et al. discloses that a copy of the work includes a human readable message indicating and verifying that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2). However, Holmes et al. does not expressly disclose that this message includes a network address of a webpage.

Johnson et al., Elsevier Science, and Holmes et al. are combinable for the reasons set forth above with regards to claim 136. Holmes et al. further discloses a message on a copy of a work indicating that the document was recreated and/or distributed in coherence with the terms and conditions agreed to at the time of purchase. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a network address of a webpage in the this message in order to more accurately maintain the formatting and look of the original document by reducing the amount of text added around the document. See column 5, lines 45-60, of Holmes et al., which discloses the importance maintaining the look of the original document.

Claims 143 and 144 recite equivalent limitations to claims 136 and 137, respectively, and are therefore rejected using the same art and rationale as set forth above.

**10. Claim 132, 134-135, and 140-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Digital Object Identifier (DOI) system.** The following references disclose aspects of the DOI system:

i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);

ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);

iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);

iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

As per claim 132, Johnson et al. teaches publishing a work of authorship and allowing a user of the third computer to click on a hot spot that allows the user to obtain the rights to the work of authorship (See figure 7, column 2, lines 20-55, column 8, lines 5-22, and column 10, lines 40-60). However, Johnson et al. does not expressly disclose and the DOI system discloses that the work is published from a server on the network with the identifier of the first work embedded such that, when the first work of authorship is displayed on the third computer and a user of the third computer clicks on a hot spot in the work of authorship, the embedded identifier is used to form a network address that links the third computer to the license offering web page for the first work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work).

Johnson et al. discloses a user viewing a published work and a network based server system with a hotspot that a user accesses to link to the terms and rights of a license in at least

figure 7, column 2, lines 20-55, column 8, lines 5-22, column 9, lines 57-67, and column 10, lines 40-60. The DOI system discloses hotspots located directly in the work that the requesting user wishes to license, clicking on hotspots to link to licensing webpages, and using a presented licensing web page associated with the work to accept the offered license terms. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate the hot spot into the published work enable the user to access the registration webpage and accept the terms in order to increase the ease of use of the system for the consumer by placing a link by which the user can automatically and efficiently accept the terms. See at least reference B, page 2, sections 1-4, and reference D, section 1, which discusses increasing the ease with which the consumer can identify the owner of a work of authorship and license said work.

As per claim 134, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, neither Johnson et al. does not expressly disclose that the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

The DOI system discloses a DOI graphic included in an electronic copy of a document, the DOI graphic including a network address of a web page, the web page verifying that the publisher is aware of the copy (i.e. through the showing of the graphic), which links the user to a

licensing page associated with the work (See reference A, page 1, section 2, reference B, page 2, sections 1-4, reference C, page 1, section 3).

Johnson et al. teaches electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. The DOI system discloses icons located directly in the work, the icon containing an address that links to a webpage with the rights information associated with the work. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate an address into a work to enable the user to verify that the copy was made with permission of the owner in order to in order to more efficiently decrease the illegal use and distribution of copyrighted works and ensure that copyright holders receive their appropriate fees by implementing efficient means by which works can be checked and verified.

As per claim 135, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose that the electronic copy includes a hotspot, that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

The DOI system discloses a hotspot (i.e. DOI graphic) included in an electronic copy of a document, the hotspot when selected causing a browser to link to a network address of a web page, the web page verifying that the publisher is aware of the copy (i.e. through the showing of the graphic), which links the user to a licensing page associated with the work (See reference A, page 1, section 2, reference B, page 2, sections 1-4, reference C, page 1, section 3).

Johnson et al. teaches electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. The DOI system discloses icons located directly in the work, the icon containing an address that links to a webpage with the rights information associated with the work. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate an address into a work to enable the user to verify that the copy was made with permission of the owner in order to in order to more efficiently decrease the illegal use and distribution of copyrighted works and ensure that copyright holders receive their appropriate fees by implementing efficient means by which works can be checked and verified.

Claims 140-141 recite equivalent limitations to claims 134-135 and are therefore rejected using the same art and rationale as set forth above.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is 571-272-6737. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bvd
July 3, 2007

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